

### Remarks

Claims 1-20 are pending. Claims 1-20 were rejected.

Claims 9 were 14 are objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. There was a typographic error in the claim number from which claim 14 was to depend. This has been corrected by the amendment to claim 14 above, which now depends from claim 11, which is a method claim. It is submitted that the amendment to the claim overcomes the objection and withdrawal of that objection is requested.

Claims 1-20 were rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. The office action states that the specification and drawings only give a general explanation of how the invention works, but not how the invention is made.

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).

It is submitted that the specification provides adequate enablement to support the claims. Using the independent claims as an example, claim 1 as amended is directed to an

operating environment emulation system, with a memory, a connector and at least one set of instructions. These elements are adequately described in the specification. For example, see the specification on page 3, lines 3-17 as amended above.

Claims 11 and claims 20 are directed to a method of establishing an emulated operating environment. It must be noted that these claims do not require any particular means or methods of providing the instruction sets, just that the sets exist. The method of accessing the instruction sets and launching the emulated environment is more than adequately supported in the specification. For example, see page 4, line 8 through page 6, line 10.

Claim 15 is directed to a method of insulating a host computer from an emulation environment, which is discussed in the specification with regard to Figure 3. See page 5, line 8 through page 6, line 10.

Having demonstrated that the specification supports the invention as claimed both to its operation and as to how it is made, it is submitted that the rejection under 35 USC 112, first paragraph has been overcome and withdrawal of that rejection is requested.

Claims 1-20 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It was pointed out accurately by the Examiner that the term 'simulation' should be 'emulation.' Indeed, in some instances, the terms were used almost interchangeable. Amendments to the specification have been made to correct this problem, where the term 'simulation' and all of its various forms have been replaced by the appropriate form of the term 'emulation.' It is submitted that these amendments do not constitute new matter, as the term emulation was used in the specification in the same manner as the term simulation. For example, see page 2, lines 29-31.

It is submitted that the term 'emulation' is adequately supported in the specification, and the independent claims have been amended to use this term in its various forms as well.

In addition, claims 9, 10 and 19 have been amended to overcome the objections with regard to 'a set' and 'selected.' It is submitted that these amendments to the specification and the claims overcome the rejection under 35 USC 112, second paragraph, and withdrawal of that rejection is requested.

Claims 1-20 are rejected under 35 USC 102(e) as being anticipated by Lew et al. (US Patent No. 6,385,567).

Lew is directed to being able to execute programs on a particular platform that are designed for another platform. See Lew, column 1, lines 36-40. The two programs and the modules for those programs, whether for the same platform or different platforms, reside on the same device. The emulation system, as amended in claim 1, has a processor to run an original operating system and the execute the set of instructions to create the emulated environment. In Lew, the multiple platform modules run an application, they do not create the emulated environment.

Claims 11 and 20 are directed to a method of emulating an operating environment. As part of the method, the emulation system must be connected to the host computer. This is not shown, taught or suggested by Lew. As discussed above, Lew is directed to running multiple platform programs on the same platform.

With regard to claim 15, Lew actively teaches away from the insulation method claimed in claim 15. Lew discusses that one loader may load modules from both the operating system of the host computer and the emulated operating system. See Lew, column 5, lines 49-60.

Therefore, for the reasons as discussed above, it is submitted that claims 1, 11, 15 and 20 are patentably distinguishable over the prior art and allowance of these claims is requested.

Claims 2-10 depend from claim 1 and should be ruled allowable for that reason and for their own merits. As discussed above, Lew does not show all of the limitations of the independent claim 1, much less the further limitations of claims 2-10.

With regard to claims 2-6, Lew may teach different connectors as part of the host system, but Lew does not teach a connector that connects an emulation system with an emulated operating system to a host computer having an original operating system. The connection of another computer having some of the modules residing on it is not the same. The modules are related to an application, not an emulation system that creates an emulated operating environment.

With regard to claims 7-10, Lew mentions that the host computer may be compatible with multiple operating systems and platforms, but not that the emulation system is of a different operating system than the host computer.

With regards to claims 12-14 depend from claim 11 and should be ruled allowable for that reason and for their own merits. Lew may teach that the user input designating a set of instructions may be directed to an application, but not to the creation of the emulation environment. This is not the same as the user selecting the environment to be emulated, the system making that selection automatically, as in claims 12 and 13. The emulation system being connected to an accessory device is not shown by Lew. Lew discusses that the host system may be an accessory device, but there is no analogy to a connectable emulation system.

As discussed above with regard to claim 15, Lew teaches that the single module loader may load modules from both the emulated operating system and the native operating

system. This does not insulate the two operating systems, and in fact connects them together. Therefore, the limitations of whether the block is a partial block, a complete block, and whether the interactions are any interactions or user-selected interactions are not shown, taught nor suggested by Lew.

It is therefore submitted that claims 2-10, 12-14, and 16-19 are patentably distinguishable over the prior art and allowance of these claims is requested.

The office action stated that prior art made of record but not relied upon are considered pertinent to the Applicant's disclosure. However, the only prior art made of record is Lew. There were two definitions provided from Webopedia™, but Applicant did not believe those were intended to be prior art.

No new matter has been added by this amendment. Allowance of all claims is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

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